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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Adrian Yap

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THE DIRECTV GROUP, INC.
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RAMAN, USHA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/837,844	Applicant(s) YAP ET AL.	
	Examiner USHA RAMAN	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 110-127 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 110-127 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 25th, 2010 has been entered.

Response to Arguments

2. Applicant's arguments filed January 25, 2010 have been fully considered but they are not persuasive.

Applicant argues (see Remarks, page 10) that, "Nowhere do these (Knudson and Hoffberg) references refer to a single event that may have been recorded before" because they relate to series or episodes of television series. However it is noted that the claim scope does not preclude scenarios involving series recording. Applicant then continues on to argue (see Remarks, page 10) that, "nowhere do these references use the electronic program guide tags, and a user-identified preference for which tags in the electronic program guide to use as a criteria for recording". Examiner however respectfully disagrees. For example, Knudson discloses that user may specify a plurality of criteria such as program times, channel, program type, etc [0085] related to the available content, wherein program data (i.e. tags) characterizing programs are embedded in an EPG [0041], [0045] and the system searches EPG for programs matching the user set criteria [0087].

Therefore Knudson teaches that user can set various criteria for recording program, wherein program guide is searched for programs matching those criteria.

Applicant argues that (see Remarks, page 10) the Hoffberg and Knudson references fail to, “selectively use these tags to terminate and erase the current recording”, and that (see remarks, page 11), “nowhere is there a user-identified preference to selectively terminate and erase the recording”. Applicant’s disclosure discloses the step of checking tag information of a program to be recorded when a recording is initiated with information recorded programs stored in the memory [0133]. Applicant’s disclosure additionally states that user may activate an automatic preference to have the control unit erase any recording of a program that is identified as a duplicate episode [0135]. While the two are related, they are two distinct steps - i.e. tags are used to determine whether or not the current recording is a duplicate and upon identification of a duplicate, based on an activated preference the duplicate episode can be selectively terminated and erased. However, the recited claim language appears to conflate these ideas into one step, suggesting that “activating the previously selected.....preference for criteria to selectively terminate and erase the recording of a program that is identified as a duplicate”, further evidenced by applicant’s arguments (see Remarks, page 10) that, “much less to selectively use these tags to terminate and erase the current recording” and (see remarks, page 11) that, “nowhere is there a user-identified preference to selectively terminate and erase the recording”. Applicant additionally argues (see Remarks, page 10-11) that, “if a previously recorded show has that particular actor in the

show, regardless of whether it is in the same series or not, the present invention would allow user to select whether or not to terminate and erase the current recording that has the same actor tag". However, it should be noted that when comparing tags to determine whether or not a current recording is a duplicate [0133]-[0134], the specification is silent on specifically using a user specified tag to make such a comparison.

Applicant argues (see Remarks, page 11) that, "Hoffberg automatically stops buffering upon a matching analysis (which may or may not be a duplicate)".

Examiner respectfully disagrees. Hoffberg discloses that upon an episode being identified, if it is determined that it is previously stored (i.e. episode is a duplicate) then the buffered data is flushed (i.e. recording is terminated and erased).

For these reasons stated above, the rejection is maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 110-127 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 110 recites the limitation, “activating the previously selected user-identified preference for criteria to selectively terminate and erase the recording of a program that is identified as a duplicate”. Applicant’s disclosure discloses the step of checking tag information of a program to be recorded when a recording is initiated with information recorded programs stored in the memory [0133]. Applicant’s disclosure additionally states that user may activate an automatic preference to have the control unit erase any recording of a program that is identified as a duplicate episode [0135]. While the two are related, they are two distinct steps - i.e. tags are used to determine whether or not the current recording is a duplicate and upon identification of a duplicate, based on an activated preference the duplicate episode can be selectively terminated and erased. However, the recited claim language appears to conflate these ideas into one step, suggesting that “activating the previously selected.....preference for criteria to selectively terminate and erase the recording of a program that is identified as a duplicate”, wherein the specification lacks support for the recited limitation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 110-113, 117-122 and 126-127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browne et al. (WO 92/22983) in view of Knudson et al. (US PG Pub. 2005/0204388) and Hoffberg et al. (US Pat. 5,901,246).

With regards to claims 110 and 119, Browne discloses an apparatus and a method of processing available content, comprising:

Receiving the available content using one or more tuners (page 9, lines 21-26); and

Performing a plurality of operations on the available content received from the one or more tuners, the plurality of operations including selecting at least one recorded event from the available content based on thumbnail, preview, or snippet (see page 30, lines 20-33 and fig. 11);

It is further noted that a current recording is buffered in the memory at the time a record operation is initiated (see Browne: page 32, lines 25-33). Browne is however silent on the step tracking a list of recorded programs for duplicates when the record operation is initiated and activating a previously selected user identified preference to selectively erase the current recording of a program that is identified as a duplicate.

In an analogous art, Knudson discloses a method of allowing user to indicate a recording preference for programs, wherein user may indicate that only previously unrecorded programs be recorded (see fig. 11, and claim 148). User may specify a plurality of criteria such as program times, channel, program type, etc [0085] related to the available content, wherein program data (i.e. tags) characterizing programs

are embedded in an EPG [0041], [0045] and the system searches EPG for programs matching the user set criteria [0087].

Hoffberg additionally discloses a similar method of recording unrecorded programs so that the user can maintain a full library of episodes of a series without duplicating episodes (col. 79, lines 3-9). Such a method as disclosed by Hoffberg is achieved by tracking a list of previously recorded programs when a record operation for a current recording is initiated (col. 81, lines 61-63). In the event it is determined that the current recording of a program is a duplicate, then the recorded portion of the current recording is erased (and therefore terminated). See col. 81, lines 65-col. 82, line 1.

It would have been obvious to one of ordinary skill in the art to modify the system of Brown in view of teachings of Knudson and Hoffberg to allow a user to indicate a preference for recording only un-recorded programs of a series, wherein when a record option is initiated, tracking a list of previously recorded programs for duplicates and in the event a current recording of a program is identified as a duplicate, terminating and erasing the current recording so that storage is efficiently managed to allow a user to maintain a full library of episodes without duplicating episodes. When the current recording is identified as a duplicate in the modified system, the current recording is erased due to a previously selected user-identified preference for recording only unrecorded programs.

With regards to claims 111, and 120, Browne teaches selecting at least one recording from the available content based on keyword (see page 30, lines 10-27

and fig. 11). The modified system therefore additionally teaches the step wherein, “performing a plurality of operations includes selecting at least one recorded event from the available content based on key word”.

With regards to claims 112, and 121, the modified system further comprises wherein the selecting is achieved by a user browsing through information related to the available content stored on at least one storage medium. See Brown: page 30, lines 5-13.

With regards to claim 113 and 122, the modified system discloses the step of checking for characteristics of duplicates when attempting to record a program from available content that has already been recorded on the storage medium (Hoffberg: column 81 lines 61-63). The modified system further discloses the step of displaying recorded contents and contents being recorded (see Browne page 24, lines 18-23 and figure 6) in storage section are displayed. Therefore it would have been obvious to one of ordinary skill in the art to further modify the system by displaying the characteristics of the selected program to record with a best match in the at least one storage for a visual comparison by the user.

With regards to claim 117 and 126, Browne discloses that users maybe provided a plurality of playback controls as depicted in figure 14, panel 1405. Among the controls provided in the aforementioned panel is an option widely recognized in the art as the rewind control (a). The “increment” is further understood to be the time that a user performs the rewind operation until he/she resumes normal playback. As such the modified system further comprises performing a plurality of

operations including “permitting a user to rewind recording in an increment for playback of a portion of the available content”.

With regards to claims 118 and 127, Browne discloses creating a personalized database from the available content, wherein the contents maybe personalized to each user 's preferences (see page 26 lines 18-29).

7. Claims 114-116, and 123-125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browne et al. (WO 92/22983) in view of Knudson et al. (US PG Pub. 2005/0204388) and Hoffberg et al. (US Pat. 5,901,246) as applied to claims 110 and 119 respectively above, and further in view of Vallone et al. (US Pat. 6,847,778)

With regards to claims 114, 115, 116, and 123, 124, and 125, the modified system does not disclose the step of displaying status of a program including a current delay that allows the user to see how far a recording is behind live feed when pausing a live signal.

In an analogous art, Vallone discloses the step of when viewing a program at it is being recorded, further displaying a trick play bar and cache bar overlaid on the screen to give an indication of visual reference points to notify the user where the live recording is at (cache bar) and where the current slider is at when the user pauses live signal. See figure 26 and description in column 18, lines 39-44, lines 55-61, and column 19, lines 60-65.

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system in view of Vallone by displaying a current delay that allows the user to see how far a recording is behind live feed when pausing a live signal. The motivation is to give the user a visual reference point on the current viewing location of the program.

With further regards to claims 114 and 123, the system as modified above displays a status (cache bar) of a program from the available content wherein a user is currently viewing the program.

With further regards to claims 115, 116, 124 and 125, the status includes at least one of current delay displayed in the cache bar that allows the viewer to see a delay between the recording and a live feed.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to USHA RAMAN whose telephone number is (571)272-7380. The examiner can normally be reached on Mon-Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2424

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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